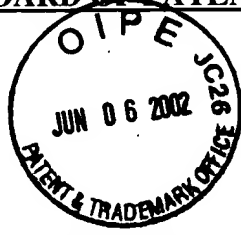


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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Browning et al.



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ORIGINALLY FILED

Serial No. 09/159,509

Filed: September 23, 1998

For: METHOD AND APPARATUS FOR  
CREATING A WIREFRAME AND  
POLYGON VIRTUAL WORLD

§ Group Art Unit: 2183

§ Examiner: Treat, William M.

§ Atty. Dkt. No.: 5181-11402

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37 C.F.R. § 1.8**

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May 28, 2002  
Date

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**REPLY BRIEF**

**Box AF**

Commissioner for Patents  
Washington D.C. 20231

Sir/Madam:

In response to the Examiner's Answer mailed March 26, 2002, Appellants present this Reply Brief. Appellants respectfully request that this reply brief be entered pursuant to 37 C.F.R. § 1.193(b)(1) and considered by the Board of Patent Appeals and Interferences.

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## **GROUPING OF CLAIMS**

In his Answer, the Examiner disagrees that claims 10-46, 48-94 and 97-108 do not stand or fall together. The Examiner states that Appellants have failed to point out why claims 10-46, 48-94 and 97-108 are separately patentable. However, in the Appeal Brief Appellants pointed out that each claim stands or falls separately because each claim must be separately analyzed to determine whether or not it is broader than the patent claims, whether or not it recaptures surrendered subject matter, and whether or not it has been materially narrowed in other respects to avoid the recapture rule. *Pannu v. Storz Instruments, Inc.*, 59 USPQ2d 1597, 1600 (Fed. Cir. 2001). The Examiner has the burden to establish applicability of the recapture doctrine for each claim separately. Since the recapture doctrine must be applied to each claim separately, each of claims 10-46, 48-94 and 97-108 stands or falls separately.

## **REPLY TO EXAMINER'S ANSWER**

### **1. Reissue Declaration**

The reissue declaration properly states errors by which the patentees claimed less than they had a right to claim in the original patent and that these errors arose without deceptive intent. In the Grounds of Rejection section of his Answer, the Examiner states that correction of this error would constitute impermissible recapture of surrendered subject matter and thus the reissue declaration is defective for not stating a proper basis for reissue. However, the new claims submitted to address the errors stated in the reissue declaration do not impermissibly recapture surrendered subject matter. "The patentee is free to acquire, through reissue, claims that are narrower in scope in all aspects than claims cancelled from the original application to obtain a patent." MPEP § 1412.02. Also, the patentee is free to acquire, through reissue, claims that are narrower than the cancelled (surrendered) claim in an aspect germane to the prior art rejection, and broader in an aspect unrelated to the rejection. *In re Clement*, 45 USPQ2d 1161, 1165 (Fed. Cir. 1997); MPEP § 1412.02. As discussed in detail below and in the Appeal Brief, claims

10-46, 48-94 and 97-108 are materially narrower than the claim that was surrendered during prosecution of the original application. Therefore, the recapture rule does not apply.

As Judge Rich stated in regard to recapture in *In re Richman*, 161 USPQ 359, 363 (C.C.P.A. 1969): "Certainly one might err without deceptive intention in adding a particular limitation where a less specific limitation regarding the same feature, or an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art." That is precisely the situation here. During the original prosecution, applicants added particular limitations where less specific limitations would have sufficed. Appellants noted this error in their reissue declaration and submitted new claims that are still materially narrower than the claim surrendered during the original prosecution, but broader than the patent claims. Appellants are not seeking to recapture the scope of the claim surrendered during the original prosecution. All of the new claims are materially narrower than the surrendered claim. Appellants are only seeking to correct their error of claiming less than they had a right to claim. Thus, the reissue declaration is not defective.

## **2. Recapture Rule**

In his Answer, the Examiner argues that his application of the recapture rule is correct in regard to the grouping means limitation because "Having argued the totality of the language defined over the prior art during the prosecution, it is not now appellants' option to selectively delete portions of the language they chose and argued." Examiner Answer, p. 8. The Examiner appears to be asserting that the recapture rule requires that any limitation added during the original prosecution to overcome the prior art must be maintained in the reissue claims in its entirety. That is simply not what the recapture rule requires. An applicant may amend a claim during prosecution to overcome the prior art. After the patent issues, the patentee may realize that the claim was amended more narrowly than necessary. Within two years of issuance, the patentee is free to seek a

broader claim through reissue as long as the claim is materially more narrow than the original claim before it was amended. In other words, the patentee cannot recapture the scope of the cancelled claim (i.e. the original claim before it was amended). But he is free to broaden the patent claims as long as they remain materially narrower than the cancelled claim. In the present reissue application, Appellants are not seeking to revert to the original claim language. Although broader than the patent claims, the new claims in the present reissue application are all materially narrower than the cancelled claim from the original application. Therefore, recapture does not apply.

In the Response section of his Answer, the Examiner quotes a single sentence from section 1412.02 of the M.P.E.P. that states: "If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejected or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists." This statement refers to a situation in which a material claim element is omitted or broadened to recapture the scope of the claim cancelled during the original prosecution. However, a claim element that was amended during the original prosecution to overcome prior art can be claimed more broadly in reissue as long as it is still materially narrower than the cancelled claim from the original prosecution.

As stated in the same section of the M.P.E.P. quoted by the Examiner, "The patentee is free to acquire, through reissue, claims that are narrower in scope in all aspects than claims cancelled from the original application to obtain a patent." By way of example, an original claim may claim a combination of elements A1, B1 and C1. During prosecution, claim element C1 may be narrowed to C3 to overcome a prior art rejection. During reissue, the patentee is free to seek a claim reciting elements A1, B1 and C2, where C2 is broader than C3 but narrower than C1. In this example, the reissue claim of A1, B1 and C2 is narrower in scope in all aspects than the cancelled claim of A1, B1 and C1 from the original application and the recapture rule would not apply. Similarly, the

patentee is free to acquire, through reissue, claims that are narrower than the cancelled claim in an aspect germane to the prior art rejection, and broader in an aspect unrelated to the rejection. *In re Clement*, 45 USPQ2d 1161, 1165 (Fed. Cir. 1997); MPEP § 1412.02. Thus, a patentee is free to seek claims during reissue that are in some aspects broader than not only the patent claims, but broader than even the original cancelled claims, as long as the reissue claims are narrower than the cancelled claim in some other aspect that is germane to the prior art rejection (i.e. materially narrower). The recapture rule clearly does not require that every single word of a limitation added to overcome a prior art rejection be maintained in the reissue claims. The recapture rule only requires that the reissue claims be materially narrower than the cancelled claim.

Numerous Federal Circuit cases illustrate that the recapture rule does not require that every single word of a limitation added to overcome a prior art rejection be maintained in the reissue claims. The Examiner's position is inconsistent with all of these cases. For example, in *Ball Corp. v. United States*, 221 USPQ 289 (Fed. Cir. 1984), an original claim for an antenna assembly recited a limitation of at least one feedline. During prosecution the claim was amended to require multiple feedlines to overcome prior art that showed a single feedline. The reissue claims did not require multiple feedlines, but did include other material limitations not present in the cancelled claims. Even though the very limitation that had been added to obtain the patent was no longer present in the reissue claims, the Federal Circuit held that the recapture rule did not apply because the reissue claims were materially narrower than the cancelled claims in other aspects.

*In re Richman*, 161 USPQ 359 (C.C.P.A. 1969) is another example of a case in which a limitation argued to obtain patentability was omitted in the reissue claims, yet the court stated that the recapture rule did not apply because each reissue claim was narrower "in at least one significant respect than the cancelled claims." *Id.* at 365. In *Richman*, the court stated that the proper question for recapture is "whether the appealed claims are of the same scope as the cancelled claims, not whether they lack some specific recitation

absent from the cancelled claims but included in the patent claims.” *Id.* at 362. Just like in *Richman*, in the present reissue application Appellants are not seeking to claim the same scope of the cancelled claims.

Another example is *In re Willingham*, 127 USPQ 211 (C.C.P.A. 1960). In *Willingham*, after an interview with the Examiner the applicant cancelled claim 12 for a deep hole drill and added claim 15 for a deep hole drill that included limitations not found in claim 12 of straight flutes, equally spaced flutes, and lands with radially positioned leading sides. The claims of the reissue application omitted these limitations that had been added with claim 15 in the original prosecution and were even broader in one aspect than cancelled claim 12. However, the court stated that the recapture rule did not apply noting that the reissue claims “differ materially from cancelled claim 12.” *Id.*

*In re Wadlinger*, 181 USPQ 826 (C.C.P.A. 1974) is another case in which the recapture rule was held not to apply because the broadened reissue claims were materially narrower than the claims cancelled from the original application.

The Examiner’s interpretation of the recapture rule is clearly at odds with the case law for the recapture rule. The Examiner’s position is that every word of a limitation added to overcome a rejection must also be found in the reissue claims. However, the case law on the recapture rule clearly demonstrates that a limitation added to overcome a rejection during the original prosecution, may be modified or even omitted as long as the reissue claim remains materially narrower than the cancelled claims (e.g. the claim prior to amendment in the original application).

In the present reissue application, all of the new claims are narrower than the surrendered claim 1 in an aspect germane to the prior art rejection, and the aspects by which they are broader than the surrendered claim are not material. “[I]f the reissue claim is narrower in an aspect germane to the prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim.” *Clement*, 45

USPQ2d at 1165. *See also, Ball*, 221 USPQ 289; *In re Wadlinger*, 181 USPQ 826 (C.C.P.A. 1974); *Richman*, 161 USPQ 359; *In re Willingham*, 127 USPQ 211 (C.C.P.A. 1960). All of the new independent claims in the present reissue application include the material limitation that virtual objects are grouped into a three-dimensional grouped object. This “three-dimensional group” limitation was present in the surrendered claim 1. From the prosecution history, it is clear that the “three-dimensional group” limitation is germane to the prior art rejection made in the original application. By inclusion of this limitation, the new reissue claims are narrower than surrendered claim 1 in an aspect germane to the prior art rejection. Thus, the recapture rule does not apply.

### 3. **Prima Facie Rejection**

In his Answer the Examiner contended that his brief discussion of claim 69 in the reissue application is sufficient to establish a *prima facie* rejection for all of claims 10-46, 48-94 and 97-108. However, the recapture rule must be analyzed separately for every claim. The Examiner performed no such analysis. As recently stated in *Pannu v. Storz Instruments, Inc.*, 59 USPQ2d 1597, 1600 (Fed. Cir. 2001): “Application of the recapture rule is a three-step process.” The third step of the *Pannu* process provides that it must be determined whether the reissue claims are materially narrower in other respects to avoid the recapture rule. *Id.* This is a restatement of the rule discussed above that the recapture rule is avoided if a reissue claim is materially narrower than the surrendered claim. The Examiner carries the burden to analyze each claim separately to determine if it is materially narrower than the surrendered claim. The Examiner clearly has not performed this analysis for each claim. The court in *Ball* stated: “The proper focus is on the scope of the claims, not on the individual feature or element purportedly given up during prosecution of the original application.” *Id.* at 295. By focusing only on totality of the language of the amendment made to the grouping means element during the original prosecution, the Examiner has failed to consider whether the scope of each separate claim is materially narrower than surrendered claim 1.

For none of the claims did the Examiner identify how each step of the *Pannu* recapture rule process was met. The Examiner only made vague references to broadening and did not identify the specific broader aspects. Nor does the Examiner explain for each claim how any broader aspects relate to surrendered subject matter. Instead the Examiner merely states that the complete wording of the amendment made to the grouping means is missing from the reissue claims. The Examiner did not consider if the reissue claims are materially narrower than the surrendered claim.

The recapture rule must be applied separately to each individual claim, including the dependent claims. Appellants assert that since the Examiner has failed to clearly identify how each step of the recapture rule is satisfied for each claim, a *prima facie* rejection has not been established under the recapture rule for the reissue claims. Many of the dependent claims include limitations that could be considered to materially narrower than the reissue claim compared to surrendered claim 1. For example, claim 38 recites: “grouping a fourth virtual object and a fifth virtual object to create a second grouped object; and grouping the second grouped object with first grouped object; and assigning a grouping hierarchy for the fourth and fifth virtual objects, wherein the fourth and fifth virtual objects are assigned as the child of the second virtual object.” These limitations are germane to the prior art rejection. As another example, claim 44 recites: “wherein said grouping the first and second virtual objects includes: selecting a first edge of said first virtual object; selecting a second edge of said second virtual object; wherein said three-dimensional grouped object comprises said first and second virtual objects joined with at least a portion of said first edge of said first virtual object contacting at least a portion of said second edge of said second virtual object.” Again, these limitations are germane to the prior art rejection.

### CONCLUSION

For the foregoing reasons, it is submitted that the Examiner’s rejection of the pending claims was erroneous, and reversal of the Examiner’s decision is respectfully



requested.

This Reply Brief is submitted in triplicate along with a return receipt postcard.

Respectfully submitted,



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